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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,800	12/09/2000	William S. Rickards III		2577

7590

01/13/2005

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EXAMINER

CHAVIS, JOHN Q

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/733,800

Applicant(s)

RICKARDS ET AL.

Examiner

John Chavis

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 41 recites the broad recitation of allowing a computer user to... and a software work product, and the claim also recites "dynamically and automatically" and "such as a document" which is the narrower statement of the range/limitation.

3. Claims 41-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, see the discussion above, which indicates that it is not clear which limitation is to be utilized (the broad or the narrow). However, it is not

considered appropriate to utilize both. For example, the definition of the term automatic is without user intervention or outside influence; however, the applicant appears to indicate that the user can perform functions automatically. The dependent claims do not fix the problems with the independent claims; therefore, it is not clear what is intended. It is also not clear what is intended by subdividing a work product, such a document, and further subdivide any subdivisions until it can not be further subdivided. This appears ambiguous to have the document documents divided in this manner; since, nothing appears to indicate the lower limit. That is, is a page the lower limit, a word or a letter and who determines this limit. At present it appears that the user makes this determination.

The features of claim 52 are not clearly understood. It appears initially that the applicant intends for the feature to not be included; then, it appears as if the applicant changed his mind near the end of the claim. Therefore, it is not clear what is intended.

Specification

4. The amendment filed 09/29/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the deletion of lines 2-3 on page 8 and lines which support this feature, for example, see page 9 lines 9-12. Therefore, the deletion is not approved and the applicant is required to insert the lines back into the specifications.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 41-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo (5,974,392).

Claims

41. (New) In a computer with a memory that is able to store data at a series of addresses in said memory,

an input means that can be used to store data in said memory at said respective series of addresses,

an output device, which is operatively connected to said memory for presenting to an output space of at least one dimension said data stored in said memory at said series of addresses, the

Endo

See fig. 2, items 4 and 7.

See items 1 and 3 of fig. 2.

See item 2 of fig. 2 and see col. 1 lines 49-54.

method of:

allowing a computer user to dynamically and automatically subdivide a software work product, such as a document, and further subdivide any subdivisions until it can not be subdivided further.

See the manager server unit of the abstract. Also, see col. 1 lines 13-24 and col. 2 lines 50-63.

42. (New) The method of Claim 41, further comprising: when displaying the whole software work product or any subdivision, automatically updating the whole software work product or any subdivision with the most current version of any and all subdivisions of what is being displayed.

See again item 3 of fig. 2 and col. 5 line 43-col. 6 line 14.

43. (New) The method of Claim 41, further comprising: having one or more participants separately control the actions on said subdivisions while not allowing one or more other participants to separately control the actions on said subdivisions.

Note in the above references how each task is specifically assigned (separately controlled).

44. (New) The method of Claim 41, further comprising: having any participant display the whole software work product or any subdivision.

See col. 9 lines 57-63 and col. 12 lines 45-55.

45. (New) The method of Claim 41, further comprising: having any participant who does not have control of any subdivision and modifies any subdivision, upon saving, the modification will not overwrite the existing stored subdivision and the participant will automatically be queried to suggest the modification as an alternative; and if permission granted, the alternative will be stored separately under the control of the participant who makes the suggestion and associated with the original subdivision that is not

See col. 2 lines 29-41, which indicates that time constraints may cause delays in task completions and tasks may be reassigned, col. 2 lines 8-28. Of course if tasks are reassigned and a person excels in the ability to perform the task. There is a possibility that the person who excels may complete the task prior to the person who receives the reassignment and would therefore, need permission to have the task entered.

under control of the participant.

46. (New) The method of Claim 41, further comprising: having any participant suggest an alternative of a software work product or any subdivision that will be stored separately under the control of the participant who makes the suggestion and associated with the original software work product or subdivision.

See the rejection of claim 45 above. Suggesting an alternative is an individual's preference and the applicant's invention as well as the patent to Endo is not construed as stifling creativity and therefore the feature is considered to be supported By both.

47. (New) The method of Claim 41, further comprising: aggregating subdivisions into a subdivision that contains said aggregated subdivisions.

See col. 9 lines 42-51.

48. (New) The method of Claim 41, further comprising: having a participant create new software work products and associate them with said subdivisions.

See col. 10 lines 11-37.

49. (New) The method of Claim 41, wherein: said subdividing further comprises physically subdividing the software work product.

See col. 10 line 51-col. 11 line 7.

50. (New) The method of Claim 41, wherein: said subdividing further comprises logically subdividing the software work product.

" " " "

51. (New) The method of Claim 41, further comprising: having a participant place controls on the kinds of actions that can occur on each subdivision.

See col. 9 lines 16-21.

52. (New) The method of Claim 41, further comprising: not storing the content of the subdivision within the parent whole work product or subdivision, but with markers to indicate subdivision location.

The feature of not storing and then "but with markers" is not clear. Also, the phrase "but with markers..." does not appear to be complete.

53. (New) The method of Claim 41, further comprising: having a participant determine what data he or she will receive about actions on said subdivisions.

See col. 13 lines 38-58.

54. (New) The method of Claim 41, further comprising: having a participant determine what data will automatically be transmitted about actions on said subdivisions to other participants.

“ “ “ “

55. (New) The method of Claim 41, further comprising: recording an action on said subdivisions.

Col.13 lines 66-col. 14 line 9.

56. (New) The method of Claim 41, further comprising: associating actions on said subdivisions.

“ “ “ “

57. (New) The method of Claim 41, further comprising: creating entirely new software work products from combining said subdivisions from other software work products.

See col. 5 line 66-col. 6 line 14.

58. (New) The method of Claim 41, further comprising: associating any subdivision with any other subdivision in the same or different software work products.

See col. 6 lines 15-28.

59. (New) A method, comprising: integrating collaboration functionality within existing software applications.

“ “ “

60. (New) The method of Claim 59, further comprising: placing a window within the application space itself.

See fig. 6 and col. 3 lines 49-50.

61. (New) The method of Claim 59, further comprising: controlling actions based on capturing comprising

See col. 4 lines 31-39.

keystrokes within the applications.

7. Applicant's arguments with respect to claims 41-61 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Chavis whose telephone number is (703) 571-3720. The examiner can normally be reached on M-Tue & Th-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703) 571-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2124

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'John Chavis', with a long horizontal flourish extending to the right.

John Chavis

Primary Examiner AU-2124